

First, the Office Action already illustrates a stated understanding of claim language, so there is no claim rejection under 35 U.S.C. § 112, second paragraph, claiming that the claim language is vague or indefinite.

Secondly, it is noted that there is no stated ground of rejection under 35 U.S.C. § 112, first paragraph, claiming that there is no support for the subject matter referenced by each of such three claims. For example, the Office Action merely objects to the language "...comparing selected of said resource utilization data..." though there is no objection or rejection grounds stated with reference to the claim language for the same claim 16 "obtaining resource utilization data for such facility." It is respectfully urged that there is adequate disclosure and support for such subject matter, wherefore the language used in the subject claims (which language is not vague and not indefinite) should be appropriately interpreted with reference to the Specification.

Therefore, it is respectfully requested that the supposed grammatical error objections be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101:

Claims 1-37 stand initially rejected under 35 U.S.C. § 103 because the claimed subject matter is allegedly directed to non-statutory subject matter. In brief summary, the subject method claims 1-37 are regarded, in essence, as "mere ideas in the abstract...."

Such initial grounds of rejection are respectfully traversed.

It is respectfully submitted that patentability of method claims such as those as recited in claims 1-37, simply involve some transformation or reduction of the involved

(i.e., claimed) subject matter. See, for example, In re Schrader, 30 U.S.P.Q.2d 1455 (Fed. Cir. 1994). Such standard is respectfully met by the present claims.

Secondly, the Office Action notes that the second prong of a test for non-statutory subject matter is said to involve whether the invention produces a useful, concrete, and tangible result.

It is respectfully noted that the subject matter of independent apparatus claim 38 substantially corresponds with the subject matter of independent method claim 1, yet there is no non-statutory subject matter rejection grounds stated for the independent apparatus claim series including claims 38-50.

Still further, it is respectfully noted that each of the present independent method claims (claims 1, 16, and 29) refer to a step of "normalizing" the "resource utilization data" based on a predefined template. Such activities clearly involve a transformation or reduction of the original data, which as outlined in the application, produces a useful, concrete and tangible result. Therefore, the present methodology involves subject matter beyond merely the perception presented by the Office Action of merely stating some desired steps for reciting data for satisfying some abstract idea.

Such normalizing feature or aspect of the presently claimed subject matter (actually recited in all four independent claims of the present application) is a transformation of data, akin to that in the State Street Bank case. Here, the recited methods produce something different from merely assembled raw data, but is instead producing a useful, concrete and tangible result. Thus, the subject claims, respectively considered as a whole, should be entitled to patent protection. See, State Street Bank

& Trust Co. v. Signature Financial Group, Inc., 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998);
cert. denied, 525 U.S. 1093.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the initial rejection of claims 1-37 under 35 U.S.C. § 101.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103:

The last 25 numbered pages of the Office Action recite various grounds of rejection of the claims under 35 U.S.C. § 103. In particular, all four independent claims, encompassed within the group of claims recited as claims 1-8, 11-18, 22, 24-31, 34-44, and 48-50, stand initially rejected under 35 U.S.C. § 103 as being unpatentable over Afsah, U.S. Patent No. 6,509,730, in view of Juneau, U.S. Patent Publication No. 2004/0015271. Such grounds of rejection are respectfully traversed.

CASE LAW BACKGROUND:

Before setting forth a discussion of the prior art applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under Section 103.

In addition to the well-known required multi-step analysis of Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966), and its progeny, the Court of Appeals for the Federal Circuit has on numerous occasions offered its guidance concerning the propriety of Section 103 rejections.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. (emphasis original)

ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed.

Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, § 103.

Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

In In re Deminski, 230 U.S.P.Q. 313 (Fed. Cir. 1986), the court reversed a Patent Office Board of Appeals decision rejecting claims for obviousness, saying: "There [was] nothing in the prior art references, singly or in combination, 'to suggest the desirability, and thus the obviousness' of the [claimed subject matter]." Id. at 315; emphasis original. The court noted that the relied-on reference did not address the technical problem addressed by the claimed invention (and in fact taught away from the Applicant's invention), and stated the well-established principle that "[h]indsight analysis is clearly improper...." Id. at 316.

In Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 U.S.P.Q. 416 (Fed. Cir. 1986), the court vacated a district court holding of invalidity for obviousness. In doing so, the district court was criticized for viewing teachings from the prior art in isolation, instead of considering the prior art references in their entirety; for entering the tempting

but forbidden zone of hindsight analysis; for failing to view the claimed invention as a whole; and for disregarding express claim limitations. Id. at 419, 420.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

Bausch & Lomb, supra, at 419 (emphasis added).

The Supreme Court in Graham and Adams ... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts. [footnote omitted] Where the legal conclusion is not supported by facts, it cannot stand....

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art.... It [the Patent Office] may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.... [W]e may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.

In re Warner, 379 F.2d 1011, ___, 154 U.S.P.Q. 173, 177, 178 (C.C.P.A. 1967; emphasis original).

"[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).

In addition, for example, in In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), a Section 103 rejection previously approved by the Board of Patent Appeals and Interferences was reversed by the Court of Appeals for the Federal Circuit. An apparatus claim recited, in essence, a means having a pumping capacity greater than

an ingredient feed rate to a mixing chamber, while the reference disclosed a variable speed arrangement merely capable of the claimed operation but not expressly suggestive thereof.

While [the prior art] apparatus may be capable of being modified to run the way [applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so. [Citing authority] ... The apparatus claimed by [applicant] is different from that of [the prior art reference]

... It is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.

In re Mills, 16 U.S.P.Q.2d 1432, 1433.

"An analysis of obviousness of a claimed combination must include consideration of the results achieved by the combination. [Quoting authority] 'Critical to the analysis is an understanding of the particular results achieved by the new combination....'" The Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, ___, 16 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1990; affirming federal district court judgment holding claims not invalid).

The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

COMMENTS:

It is respectfully noted that the Office Action recites in a number of instances aspects of the claimed subject matter which are already expressly recognized in the Office Action as not being shown or suggested by the base reference Afsah. For example, the bottom of page 7 of the Office Action observed in pertinent part that "...Afsah does not expressly teach that the method for modeling the performance of a facility utilizes pre-defined templates that contained default data, the use of a

template/facility editors or that the model is embodied as an apparatus (system)."

Further, from the middle of page 10, the Office Action expressly notes that Afsah does not expressly teach use of an apparatus for a methodology of selecting attributes for one or more facilities. Still further, it is conceded near the bottom of page 12 of the Office Action that "Afsah does not expressly teach that the method for modeling the performance of a facility further comprises a template editor ... to assign attributes to a facility." Still further, near the top of numbered page 14 of the Office Action, it is conceded that "Afsah does not expressly teach the method for modeling the performance of a facility utilizes an attributes list ... maintained in an electronic storage."

Still additionally, it is conceded on the middle of numbered page 15 of the Office Action with respect to various claims that "Afsah does not teach that the method for modeling the performance of a facility further comprises the reclassification of attributes as claimed." Similarly, near the top of page 17, it is conceded that Afsah is silent with respect to any specific mechanism for activating a data normalization step or process, just as it is conceded near the middle of numbered page 18 of the Office Action that Afsah does not expressly teach estimating, predicting, or calculating facility attribute and resource utilization data for any period of time in the past.

Still further, near the bottom of numbered page 21 of the Office Action, it is conceded that "Afsah does not expressly teach that the method for modeling the performance of a facility provides an editor for managing the plurality of facilities and/or attributes as claimed."

There are additional instances where it is either already expressly conceded that the base reference Afsah does not include nor suggest the indicated subject matter, or such is the case, whether otherwise conceded or not.

Still further, in some instances, the Office Action concedes that both such references Afsah and the Juneau published patent application fail to expressly disclose or teach presently claimed subject matter, wherefore (at the top of numbered page 24) the Office Action further proposes the additional combination of Machin et al., U.S. Patent No. 6,877,034, as rendering obvious such noted subject matter not found within Afsah nor Juneau. Specifically, the bottom of numbered page 24 of the Office Action recites that "Neither Afsah nor Juneau expressly teaches that the method for modeling the performance of a facility further comprises aggregating (grouping, clustering, segmenting, etc.) the resource utilization and/or facility attribute data based (according to) user defined criteria." It is respectfully submitted that none of such three references, alone or in combination, render obvious the presently claimed subject matter.

In additional instances, the Office Action allegedly takes "official notice" of various claimed features, which are admittedly not found in any of such three references. For example, the middle of numbered page 15 of the Office Action asserts that the creation of new categories of attributes based on a triggering event is old and well known in the art. Even so, numbered page 17 of the Office Action recites that the non-supplied triggering aspects are likewise something which are allegedly "well known in the art". Thus, multiple, inter-functional aspects are separately regarded as "well known" and apparently their combination with other subject matter is simply regarded as "obvious" without benefit of any demonstrated teachings.

The assertions of "official notice" are respectfully traversed in the contexts stated, and copies of supporting references are respectfully requested (if the positions are continued), in accordance with current USPTO practice.

In view of the foregoing approach to the Office Action, it is respectfully urged that the Office Action in effect amounts to an attempted cobbling together of mere pieces of alleged suggestions from the prior art, in combination with other aspects not shown by any prior art cited (but instead said to be via "official notice"), all respectfully improperly guided through hindsight consideration of the claimed subject matter.

For example, as earlier noted, near the bottom of numbered page 7 of the Office Action, it is expressly conceded that "...Afsah does not expressly teach that the method for modeling the performance of a facility utilizes pre-defined templates that contain default data...." However, when asserting the Juneau published patent application in conjunction with such subject matter, the Office Action (top of numbered page 8 thereof) asserts disclosure of the subject matter "predefined facility template" even though such language does not appear anywhere in such published '271 Juneau patent application.

As further evidence that the Office Action positions amount to a cobbling together of selected pieces of references (and non-references), improperly guided through hindsight consideration of the claims, it is noted that each of the present four independent claims (claims 1, 16, 29, and 38) each recite the above-referenced "normalizing" feature of the present subject matter. Yet the terminology "normalize" and the terminology "normalizing" do not appear in any of the three references applied by the Office Action: not in the Afsah '730 patent, not in the Juneau '271 published patent application, and not in the Machin et al. '034 patent.

Similarly, there is only very limited disclosure of a "dynamic" system, as generally referenced in the present claims (including claims 16-50). Again, Afsah '730 patent makes no reference to "dynamic" features whatsoever. The Machin et al. '034 patent only uses the term "dynamically" a single time (and does not use the term "dynamic" whatsoever). Specifically, in column 2, line 5, the Machin et al. '034 patent merely recites a reference to "...dynamically changing industries...." Likewise, the Juneau '271 published patent application recites a single reference to "dynamic", in paragraph [0006] thereof, with reference to the invention supposedly being a dynamic system, but again without benefit of any "normalizing" feature as recited in all of the present claims 1-50.

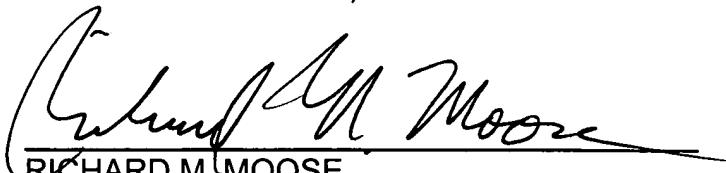
CONCLUSION:

In view of the foregoing, Applicant respectfully submits that the present application, including claims 1-50 thereof, fully complies with all requirements of 35 U.S.C. § 112, and 35 U.S.C. § 101, and clearly and patentably defines over the applied references, wherefore reconsideration and allowance of present claims 1-50 are respectfully requested.

Respectfully submitted,

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